



Patent

HF-54

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Walter Hörburger, et al
Serial No: 09/759,543
U.S. Filed: January 12, 2001
For: LEVEL
Examiner: 2859
Art Unit: Gail Kaplan Verbitsky

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 2213-1450

SUBMISSION OF BRIEF ON APPEAL

SIR:


Submitted herewith is a Brief On Appeal in triplicate in support of the Appeal filed May 7, 2004.

A check in the amount of \$ 165.00 to cover the appeal fee pursuant to 37 CFR §1.17 (f) is enclosed.

Any additional fees or charges required at this time in connection with the application may be charged to Patent and Trademark Office Deposit Account No. 11-1835.


Respectfully submitted,

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Dated: July 7, 2004
Encls: Check (\$ 165.00)

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By:  Date: July 7, 2004
Friedrich Kueffner



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BRIEF ON APPEAL

S I R:

This Brief is submitted in support of the Appeal filed May 7, 2004 from the Examiner's Final Rejection of claims 1 to 5 as set forth in the Office Action dated March 12, 2004.

REAL PARTY IN INTEREST

The present application is owned by SOLA-Meßwerkzeuge GmbH by virtue of an assignment submitted for recordation on April 23, 2004 from Sola-Meßwerkzeuge Gesellschaft m.b.H. & Co. which previously owned the present application.

RELATED APPEALS AND INTERFERENCES

There are no presently pending related appeals and interferences.

STATUS OF CLAIMS

Claims 1 - 5 are the claims in the application and are the claims on appeal.

STATUS OF AMENDMENTS

An Amendment after final rejection in response to the Examiner's final rejection of the claims dated March 12, 2004 was not filed.

SUMMARY OF THE INVENTION

The present invention is directed to a level.

As illustrated in the drawing and described in the first paragraph on page 7 of the specification, the level includes a level body 1 and at least one bubble level 7 mounted in the level body 1. As described in the second paragraph on page 7 of the specification, the level body 1 is of a foamed metal.

As also described in the second paragraph on page 7 of the specification, the level body 1 is of foamed aluminum.

As described in the first paragraph on page 7 of the specification, the level body 1 is provided with a coating of synthetic material.

As described in the first paragraph on page 7 of the specification, the level body 1 has at least one recess 2, 3 for at least one bubble level.

As described in the second paragraph on page 7 of the specification, the level body 1 has an inner portion 5 of porous metal and portions 6 adjacent the surfaces of the level

body which are of a less or hardly porous metal and form an essentially closed outer skin.

ISSUES PRESENTED FOR REVIEW

Whether claim 1 is unpatentable under 35 U.S.C. §103(a) over Goss et al. in view of Patten; whether claims 1 and 2 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over Goss in view of Brungs; whether claims 1 to 3 and 5 are unpatentable under 35 U.S.C. 103(a) over Goss in view of Niebylski; whether claim 3 is unpatentable under 35 U.S.C. 103(a) over Goss in view of Richardson; and whether claim 4 is unpatentable under 35 U.S.C. 103(a) over Goss and Patten as applied to claim 1, and further in view of Provi.

GROUPING OF CLAIMS

Claims 2 to 5 stand or fall with claim 1.

ARGUMENT

It is respectfully submitted that the Examiner's rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over

Goss et al. in view of Patten is in error because the references do not disclose or suggest the present level as claimed.

The patent to Goss discloses a spirit level having a level housing 54. There is no discussion by Goss concerning the material of the level body. There is no teaching concerning a level body of a foamed metal as in the presently claimed invention.

The patent to Patten discloses closed cell foam metal.

The Examiner combined these references in determining that claim 1 would be unpatentable over such a combination. Applicant respectfully submits that it would not be obvious to combine these references and there is no motivation provided in the references for such a combination. The Examiner argues that the combination is obvious in order to provide a light-weight level. With the amendment dated December 3, 2003, applicant submitted a table listing various hollow and synthetic levels and their weight in grams per meter (g/m). As is evident, hollow aluminum levels have a weight essentially between 360 and 520 g/m. A foamed aluminum level body pursuant to the present invention has a weight of about 1000 g/m. Thus, the present invention does not make a level that is lighter than the prior art. Furthermore,

since the present invention does not have the objective of providing a lighter level, the motivation to combine the references to provide a lighter weight level as argued by the Examiner is of no relevance to the present invention. Thus, it is respectfully submitted that there is no motivation for combining the references to arrive at the presently claimed invention, which has a foamed metal body that is heavier than the prior art aluminum levels.

A level body made of foamed metal can be produced so that the body is essentially distortion free due to the uniform shrinkage of the foamed aluminum during cooling. A foamed plastic body does not shrink uniformly and thus can result in deformities. Also, a hollow aluminum body requires additional working steps to finish the measuring surface. Such steps are not necessary with a foamed metal body. There is no mention of these benefits of a foamed body for a level in either Goss or Patten. The only way in which these references are combinable, if they are combinable at all, is by impermissible hindsight reconstruction of the invention based upon the teachings of the present application.

In view of these considerations it is respectfully submitted that the rejection of claim 1 under 35 U.S.C. 103(a) over a

combination of the references to Goss et al. and Patten is in error.

The patent to Brungs discloses a foamed metal body. The Examiner combined this reference with Goss in determining that claims 1-2 would be unpatentable over such a combination. Applicant submits that the reasoning provided above in connection with the combination of Goss and Patten applies equally here. There is no suggestion for combining Brungs and Goss as argued by the Examiner to arrive at the presently claimed invention.

In view of these considerations it is respectfully submitted that the rejection of claims 1-2 under 35 U.S.C. 103(a) over a combination of references to Goss and Brungs is in error.

The patent to Niebylski discloses a coated foamed body. The Examiner combined this reference with Goss in determining that claims 1-3 and 5 would be unpatentable over such a combination. Applicant respectfully submits that there is nothing in the teachings of either of these references which would suggest a level body of a foamed metal as in the claims presently on file. The arguments presented previously apply equally to this rejection. A light-weight level is not the object of the present

invention and thus there is not motivation for combining the references as argued by the Examiner.

In view of these considerations it is respectfully submitted that the rejection of claims 1-3 and 5 under 35 U.S.C. 103(a) over a combination of the above-discussed references is overcome and should be withdrawn.

The patents to Richardson and Provi have also been considered. These references do not come closer to the presently claimed invention than the references discussed above and thus any detailed comments thereon would be superfluous. Neither of these references has any suggestion for a foamed metal level body. Therefore, it is respectfully submitted that the rejections of claims 3 and 4 under 35 U.S.C. 103(a) are also in error.

In the "Response to Arguments" in the office action dated March 12, 2004, the Examiner has correctly indicated that there is no requirement that a motivation to make a modification be expressly articulated in the prior art. However, as also mentioned by the Examiner, there should be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references.

As stated in the application as originally filed, the motivation to make the level body of a foamed metal material is because this makes it possible to manufacture an extremely accurate level with an extremely uniform shrinkage over the length of the level body, so that a very accurate level is obtained without requiring any further processing of the measuring surface of the level.

The Examiner, on the other hand, states that a combination of the references of Goss and Patten will result in an article which is light weighted, has a high damping coefficient and a high stiffness-to-density ratio. As discussed above, these are not the objects of the present invention. Accordingly, the Examiner has not shown that it was obvious to combine the references as set forth in the rejections of the office action of March 12, 2004.

In view of the foregoing, it is submitted that the claims are allowable over the references relied on by the Examiner and the Board is respectfully requested to reverse the decision of the Examiner.

Respectfully submitted,

Dated: July 7, 2004

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MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 7, 2004.

By: *F. Kueffner* Date: July 7, 2004
Friedrich Kueffner

APPENDIX

CLAIMS ON APPEAL

1. A level comprising a level body and at least one bubble level mounted in the level body, wherein the level body is of a foamed metal.

2. The level according to claim 1, wherein the foamed metal is foamed aluminum.

3. The level according to claim 1, wherein the level body has a coating of a synthetic material.

4. The level according to claim 1, wherein the level body has at least one recess for the at least one bubble level.

5. The level according to claim 1, wherein the level body has an inner portion of porous metal and portions adjacent surfaces of the level body which are of a less or hardly porous metal and form an essentially closed outer skin.